

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-14 and 16-21 are presently pending in this case. Claims 13 and 14 are amended, Claim 15 is canceled without prejudice or disclaimer, and new Claims 16-21 are added by the present amendment. As amended Claims 13 and 14 and new Claims 16-21 are supported by the original claims, no new matter is added.

In the outstanding Official Action, Claims 1-12, 14, and 15 were rejected under 35 U.S.C. §101; and Claims 1-15 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over Claims 1-13 of U.S. Patent Application No. 11/514,255.

The abstract is amended herewith to place it in conformance with U.S. practice. No new matter is added.

With regard to the rejection of Claims 1-12, 14, and 15 under 35 U.S.C. §101, Claim 15 is canceled without prejudice or disclaimer. Claim 14 is amended to recite “a computer readable medium,” which is article of manufacture, and to recite “a processor.” With regard to Claims 1-12, these claims are directed to an information processing apparatus and recite means-plus-function terminology. Proper claim interpretation of a means-plus-function (35 U.S.C. § 112, sixth paragraph) element entails consideration of the structures disclosed in the specification and equivalents thereof. In determining the scope of the claims prior to determining compliance with each statutory requirement for patentability, MPEP §2106 provides:

Office personnel are to correlate each claim limitation to all portions of the disclosure that describes the claim limitation. This is to be done in all cases, i.e., whether or not the claimed invention is defined using *means or step plus function language*. The correlation step will ensure that office personnel will correctly interpret each claim limitation. (emphasis added).

Thus, it is respectfully submitted that the rejection under 35 U.S.C. §101 of Claims 1-12 are improper as these claims clearly recite apparatus claim limitations.

MPEP §2106 further provides that:

Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof" that correspond to the recited function. Two en banc decisions of the Federal Circuit have made clear that the USPTO is to interpret means plus function language according to 35 U.S.C. §112, sixth paragraph. In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc); In re Alappat, 33 F.3d 1526, 1540, 31 USPQ2d 1545, 1554 (Fed. Cir. 1994) (en banc). (emphasis added) See MPEP § 2106.

The rejection merely includes the conclusory statement “Regarding Claims 1-12, all the ‘means’ are software components that fails to constitute a hardware apparatus.” Thus, it is respectfully submitted that no express statement has been provided as to how the language of the claims have been interpreted to support the 35 U.S.C. §101 rejection in violation of the guidelines of MPEP §2106.

Accordingly, should such a rejection be maintained in a subsequent communication with respect to any of the aforementioned claims, it is respectfully requested that the Office Action provide an express statement on the record in accordance with MPEP §2106 guidelines explaining how such claim terminology, such as “attribute information obtaining means,” “operation history obtaining means,” “preference information generating means,” and “recommendation information generating means” is interpreted. More specifically, how the structure identified as corresponding to such limitations is deficient to define a particular machine or apparatus.

Consequently, it is respectfully submitted that Claims 1-12 and 14 are in compliance with all requirements under 35 U.S.C. §101.

With regard to the provisional non-statutory double patenting rejection of Claims 1-15 over Claims 1-13 of U.S. Patent Application No. 11/514,255, the rejection is respectfully traversed in light of the terminal disclaimer submitted herewith.

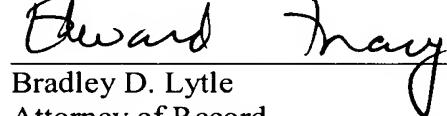
The filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. The "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection." *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). Accordingly, Applicants filing of the attached disclaimer is provided for facilitating a timely resolution to prosecution only, and should not be interpreted as an admission as to the merits of the obviated rejection.

New Claims 16-21 are supported at least by original Claims 1-6. As these claims recite an apparatus, new Claims 16-21 also define statutory subject matter.

Accordingly, the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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